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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91221141
Party	Defendant JS Products, Inc.
Correspondence Address	PAUL G JUETTNER GREER BURNS & CRAIN LTD 300 S WACKER DR , SUITE 2500 CHICAGO, IL 60606 UNITED STATES pjuettner@gbclaw.net, tproehl@gbclaw.net, tmdocket@gbclaw.net
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Tanja Proehl
Filer's e-mail	tproehl@gbclaw.net, tmdocket@gbclaw.net
Signature	/Tanja Proehl/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Stanley Logistics, LLC,)	
)	
Opposer,)	Opposition No. 91221141
)	
v.)	Serial No. 86/321,980
)	
JS Products Inc.,)	
)	
Applicant.)	
)	

**APPLICANT’S MOTION TO DISMISS THE AMENDED
NOTICE OF OPPOSITION FOR FAILURE TO STATE A CLAIM
UNDER RULE 12(b)(6) WITH RESPECT TO OPPOSER’S COUNT II**

Applicant JS Products Inc., (“Applicant”) moves this Honorable Board to dismiss the Amended Notice of Opposition filed by Opposer Stanley Logistics, LLC (“Opposer”) for failure to state a claim upon which relief may be granted pursuant to Rule 12(b)(6) Fed.R.Civ.P. with respect to Count II. Applicant submits herewith a Memorandum in support of its Motion, and more specifically avers as follows:

1. Opposer filed a Notice of Opposition on March 18, 2015 with the Trademark Trial and Appeal Board on the grounds of Likelihood of Confusion (Count I), Deceptiveness / False Suggestion of a Connection (Count II) and Dilution (Count III).
2. On May 26, 2015 Opposer filed a Motion to Consolidate this Opposition No. 91221141 with Opposition No. 91221566.¹

¹ Applicant is also filing a Motion to Dismiss the Amended Notice of Opposition filed by Opposer for failure to state a claim under Rule 12(b)(6) with respect to opposer’s count II in Opposition No. 91221566 (child) and in Opposition No. 91223439.

3. On July 16, 2015 the Board granted the Motion to Consolidate and also determined *sua sponte* that Count II (“deception/false suggestion of a connection”) in each notice of opposition was legally insufficient and struck the same.

4. Opposer was allowed to file an Amended Notice of Opposition in each proceeding by August 7, 2015 properly alleging a ground of false suggestion of a connection and/or deceptiveness, should Opposer have a basis for such claim(s).

5. On August 5, 2015 Opposer filed an Amended Notice of Opposition including a revised Count II.

6. In the revised Count II of the Amended Notice of Opposition Opposer still has not sufficiently alleged a ground of false suggestion of a connection and/or deceptiveness under Section 2(a) of the Trademark Act.

7. Since Opposer has not sufficiently alleged and cannot allege a Section 2(a) ground for opposition, its Amended Notice of Opposition with regards to Count II must be dismissed under Rule 12(b)(6) of the Federal Rules of Civil Procedure for failure to state a claim upon which relief may be granted.

WHEREFORE, Applicant prays that its motion be granted and the Amended Notice of Opposition be dismissed with respect to Count II.

Respectfully submitted,

By: /s/ Tanja Proehl
Paul G. Juettner
Tanja Proehl
Attorneys for APPLICANT

GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive
Suite 2500
Chicago, Illinois
Telephone: (312) 360-0080
Facsimile: (312) 360-9315

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing APPLICANT'S MOTION TO DISMISS THE AMENDED NOTICE OF OPPOSITION FOR FAILURE TO STATE A CLAIM UNDER RULE 12(b)(6) WITH RESPECT TO OPPOSER'S COUNT II has been served upon the following counsel for Opposer:

James R. Davis, II
Arent Fox LLP
1717 K Street, NW
Washington, DC 20006-5344
davis.jim@arentfox.com
mitchell.justine@arentfox.com
TMdocket@arentfox.com

by email as agreed upon, on this 28 day of August, 2015.

By: /s/ Tanja Proehl
Tanja Proehl
Attorney for APPLICANT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Stanley Logistics, LLC,)	
)	
Opposer,)	Opposition No. 91221141
)	
v.)	Serial No. 86/321,980
)	
JS Products Inc.,)	
)	
Applicant.)	
)	

**APPLICANT’S MEMORANDUM IN SUPPORT OF
ITS MOTION TO DISMISS AMENDED NOTICE OF
OPPOSITION FOR FAILURE TO STATE A CLAIM
UNDER RULE 12(b)(6) WITH RESPECT TO COUNT II**

Applicant, JS Products Inc. (“Applicant”) submits this memorandum in support of its Motion to Dismiss Amended Notice of Opposition filed by Opposer Stanley Logistics, LLC (“Opposer”) for failure to state a claim upon which relief may be granted pursuant to Rule 12(b)(6) Fed.R.Civ.P. with respect to Count II.

FACTS

Opposer filed a Notice of Opposition on March 18, 2015 with the Trademark Trial and Appeal Board on the grounds of Likelihood of Confusion (Count I), Deceptiveness / False Suggestion of a Connection (Count II) and Dilution (Count III). On May 26, 2015 Opposer filed a Motion to Consolidate this Opposition No. 91221141 with Opposition No.

91221566.¹ On July 16, 2015 the Board granted the Motion to Consolidate and also determined that Count II (“deception/false suggestion of a connection”) in each Notice of Opposition was insufficient and struck Count II *sua sponte*. Opposer was allowed leave to file an Amended Notice of Opposition in each proceeding by August 7, 2015 that properly alleges a ground of false suggestion of a connection and/or deceptiveness, should Opposer have a basis for such claim(s). On August 5, 2015 Opposer filed an Amended Notice of Opposition including a revised Count II.

In the revised Count II of the Amended Notice of Opposition Opposer has still not sufficiently alleged and cannot allege a ground of false suggestion of a connection and/or deceptiveness. Specifically, Opposer has made the following allegations:

6. By reason of its extensive marketing, advertising, and promotion, Stanley's PROTO marks have become uniquely associated with Stanley and serve as part of Stanley's identity with consumers.

7. Stanley's PROTO marks have become well-known and famous as distinctive indicators of the origin of Stanley's goods and services, and the PROTO marks are valuable symbols of Stanley's goodwill and identity.

20. Applicant's mark PROTOCOL misdescribes the character, quality, function, composition or use of the applied-for goods; prospective purchasers are likely to believe that the misdescription actually describes the applied-for goods; and the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase.

21. Applicant's mark PROTOCOL falsely suggests a connection with Stanley because Applicant's mark is the same as, or a close approximation of, Stanley's PROTO name and/or identity; Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to Stanley; Stanley is not connected with goods sold under Applicant's mark; and Stanley's fame and reputation is such that, when Applicant's mark is used with Applicant's goods and services, a connection with Stanley would be presumed.

¹ Applicant is also filing a Motion to Dismiss the Amended Notice of Opposition filed by Opposer for failure to state a claim under Rule 12(b)(6) with respect to Opposer's Count II in Opposition No. 91221566 and in Opposition No. 91223439.

ARGUMENT

A. Opposer Has Not and Cannot Allege A Section 2(a) Deception Claim.

The Board may dismiss a claim if it appears that the Opposer can prove no set of facts in support of pled allegations which would entitle him to relief. Fed.R.Civ.P. 12(b)(6); TBMP §503.02. In the present case, Opposer cannot plausibly allege a Section 2(a) deception claim. 15 USC §1052(a).

As stated in the Board's Order dated July 16, 2015, in order to properly assert a ground that the mark is deceptive, Opposer must plead that (1) Applicant's mark misdescribes the character, quality, function, composition or use of the goods, (2) prospective purchasers are likely to believe that the misdescription actually describes the goods, and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase. See In re Spirits Int'l, N.V., 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); and In re Budge Mfg. Co., 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), aff'g 8 USPQ2d 1790 (TTAB 1987). See also In re White Jasmine LLC, 106 USPQ2d 1385 (TTAB 2013).

In paragraph 20 of the Amended Notice of Opposition, Opposer alleges that "Applicant's mark PROTOCOL misdescribes the character, quality, function, composition or use of the applied-for goods; prospective purchasers are likely to believe that the misdescription actually describes the applied-for goods; and the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase."

Opposer simply has made a conclusory allegation of the elements of a Section 2(a) deception claim as provided in the Board's July 16 Order. Opposer has not made any factual allegations in support of its claim. In particular, the first prong of the

deception test cannot be met because Applicant's Mark "PROTOCOL" does not describe any of the goods covered in the Application, such as "hand tools, namely axes, clamps, knives, saws, saw blades, cutters, punches, chisels, pliers, screwdrivers, nut drivers, hammers, and drill bits." Therefore, the mark PROTOCOL is incapable of misdescribing the character, quality, function, composition or use of the recited goods. For this reason alone, a deceptiveness claim is inapplicable on its face.

The true gravamen of Opposer's deceptiveness claim is that the public will likely be deceived (allegedly) as to the source of the goods because Applicant's PROTOCOL mark is allegedly similar to Opposer's PROTO mark. However, this is an ordinary Section 2(d) claim, not a Section 2(a) deceptiveness claim as explained by the Board in its earlier Order. Accordingly, the portion of Opposer's Count II purporting to assert a deceptiveness claim must be dismissed.

B. Opposer Cannot Allege False Suggestion Of A Connection.

In the present case, Opposer has not and cannot plausibly allege a false suggestion of a connection claim under Section 2(a) because "PROTO" is a trademark owned by Opposer, not its name or identity.

As stated in the Board's July 16 Order, in order to properly assert a ground of false suggestion of a connection, Opposer must plead that (1) Applicant's mark is the same or a close approximation of Opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) that Opposer is not connected with the goods sold by Applicant under the mark; and (4) that Opposer's name or identity is of sufficient fame or reputation that when Applicant's

mark is used on its goods, a connection with Opposer would be presumed. See Boston Red Sox Baseball Club LP v. Sherman, 88 USPQ2d 1581 (TTAB 2008); and Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985).

Again, Opposer's Amended Notice of Opposition does not allege facts that Opposer's PROTO marks are Opposer's name or identity, apart from being a trademark. Specifically, paragraph 21 alleges that "Applicant's mark PROTOCOL falsely suggests a connection with Stanley because Applicant's mark is the same as, or a close approximation of, Stanley's PROTO name and/or identity" (emphasis added). However, Opposer's name is Stanley Logistics, not PROTO. Opposer does not allege any facts that the term PROTO is or ever was Opposer's previously used name. Further, Opposer does not allege facts that Applicant's mark is the same as or a close approximation of Opposer's "identity."

The Federal Circuit and this Board have explained that a claim for falsely suggesting a connection with persons under Section 2(a) is distinctly different than a trademark claim under Section 2(d). University of Notre Dame du Lac v. J.C. Food Imports Co., Inc., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); Buffett v. Chi-Chi's, Inc., 226 USPQ 428,429 (TTAB 1985). The interest to be protected is a person's identity or persona and is more akin to invasion of privacy than trademark infringement. Id. The cases have recognized identity or persona rights in names, likenesses and nicknames, but not in a trademark alone. See, Carson v. Here's Johnny Portable Toilets, Inc., 698 F.2d 831, 218 USPQ 1, 4 (6th Cir. 1983)(collecting right of publicity "identity" cases). The courts have not gone so far as to find that a trademark alone can qualify as a person's "identity" under Section 2(a) of the Trademark Act. In Boston Red Sox Baseball Club LP

v. Sherman, 88 USPQ2d 1581 (TTAB 2008) the Board found that “there is no question that the name “Red Sox” is the identity of the baseball club, apart from being a trademark for the entertainment services the club provides.” Id. at 1589 (emphasis added).

In the Amended Notice of Opposition there is no factual allegation that the term PROTO is anything more than a trademark owned by Opposer. Opposer’s allegations that “Stanley's PROTO marks have become uniquely associated with Stanley and serve as part of Stanley’s identity with consumers” (Opposition ¶ 6) and that “Stanley's PROTO marks have become well-known and famous as distinctive indicators of the origin of Stanley's goods and services, and the PROTO marks are valuable symbols of Stanley's goodwill and identity” (Opposition ¶ 7) do not save the claim. The same allegations that a plaintiff’s or opposer’s trademark is part of its identity with consumers and is a valuable symbol of its goodwill and identity could be made in any Section 2(d) trademark case. As with its deceptiveness allegations, Opposer is attempting to improperly multiply its Section 2(d) claim, and for this reasons the claim must be dismissed.

CONCLUSION

Since Opposer has not and cannot allege deception and false suggestion of a connection claim, Count II of its Amended Notice of Opposition must be dismissed under Rule 12(b)(6) of the Federal Rules of Civil Procedure for failure to state a claim upon which relief may be granted.

Applicant respectfully requests that the deadline for Applicant to file an answer to the Amended Notice of Opposition be reset for 30 days after the Board rules on Applicant’s Motion to Dismiss, and that the opposition schedule be reset accordingly.

Respectfully submitted,

By: /s/ Tanja Proehl
Paul G. Juettner
Tanja Proehl
Attorneys for APPLICANT

GREER, BURNS & CRAIN, LTD.
300 South Wacker Drive
Suite 2500
Chicago, Illinois
Telephone: (312) 360-0080
Facsimile: (312) 360-9315

